

REMARKS

The present application was filed on June 29, 2001 with claims 1-39. Claims 1, 21, 25 and 39 are the independent claims.

In the outstanding Office Action dated August 21, 2007, the Examiner rejected claims 1-39 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,857,020 to Chaar et al. (hereinafter "Chaar").

Applicants have submitted herewith a Request for Continued Examination under 37 CFR §1.114 along with the fee under 37 CFR §1.17(e). Thus, Applicants respectfully request that prosecution be reopened and that the present amendments be entered. Applicants moreover request reconsideration of the present application in view of the amendments above and the remarks below.

With regard to the §102 rejection, Applicants initially note that MPEP §2131 specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention . . . in as complete detail as is contained in the . . . claim," citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants further note that both Chaar (Reel/Frame 011908/0621) and the present application (Reel/Frame 012247/0426) are currently assigned of record to International Business Machines Corporation (IBM). Furthermore, both Chaar and the claimed invention were subject to an obligation of assignment to IBM at the time the claimed invention was made. Because Chaar qualifies as prior art only under 35 U.S.C. §102(e), Applicant respectfully note that, pursuant to 35 U.S.C. §103(c), Chaar may not be used in any possible rejection under 35 U.S.C. §103(a).

Applicants have amended claims 1, 21, 25 and 39 in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

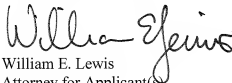
Specifically, independent claims 1, 21, 25 and 39 have been amended without prejudice solely to clarify the scope of the claimed subject matter. As amended, these claims recite limitations directed to constructing, as well as maintaining, an electronic contract that contains information pertaining to descriptions of one or more business transactions in IT terms, financial implications of one or more business transaction service levels, and reporting to be performed in one or more financial terms. Support for this amendment may be found in the present specification at, for example, page 11, lines 22-23 (“The ecBuilder 340 constructs the contract based on the analyst-specified requirements.”)

Not only does Chaar fail to disclose this limitation directed to constructing an electronic contract, but it in fact teaches away by instead disclosing arrangements that require the use of an established e-business SLA contract. See Chaar at, for example, column 7, lines 49-50; column 8, lines 29-32; column 8, lines 47-50; and column 8, lines 64-66.

Dependent claims 2-20, 22-24 and 26-38 are believed allowable at least by virtue of their dependence from independent claims 1, 21 and 25, respectively. Additionally, one or more of these claims define independently patentable subject matter.

In view of the above, Applicants believe that claims 1-39 are in condition for allowance, and respectfully request withdrawal of the §102(e) rejection.

Respectfully submitted,



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